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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/814,495 | 03/21/2001 | Daniel B. Baer | LBRE:034 | 4599 |

7590 01/26/2005

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| EXAMINER | |
|---|---|
| CIRIC, LJILJANA V | |
| **ART UNIT** | **PAPER NUMBER** |
| 3753 | |

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/814,495 | BAER, DANIEL B.- | |
| | Examiner | Art Unit | |
| | Ljiljana (Lil) V. Ciric | 3753 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *26 October 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-14 and 16-19* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6,8-11,13,14 and 16* is/are rejected.

7)☒ Claim(s) *7,12 and 17-19* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 January 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 26, 2004 has been entered.

### *Response to Arguments*

2. Applicant's arguments filed on October 26, 2004 with regard to the previously cited prior art rejections of the claims have been fully considered but they are generally not persuasive.

In response to applicant's arguments regarding the purported non-applicability of the Parmelee et al, Cowans, and Chu et al. references to the apparatus claims, the examiner hereby respectfully notes that that claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). Also, "[A]pparatus claims cover what a device *is*, not what a device *does*. (Emphasis in original). *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Furthermore, the applicant cannot rely on language that makes a limitation optional for patentability. For example, the examiner hereby notes that, according to MPEP 2106, as a general matter, language that suggests or makes optional but does not require steps to be

performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

(A) statements of intended use or field of use,

(B) **"adapted to"** or "adapted for" clauses,

(C) **"wherein"** clauses, or

(D) "whereby" clauses.

This list of examples is not intended to be exhaustive.

Finally, applicant is respectfully reminded that claims in a pending application should be given their broadest reasonable interpretation. *In re Pearson*, 181 USPQ 641 (CCPA 1974).

Thus, with regard to the apparatus claims, applicant's arguments thus fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Applicant's arguments also thus do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

***Specification***

3. Receipt and entry of the amended abstract is hereby acknowledged.

## *Claim Rejections - 35 U.S.C. § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1 through 3, 5, 8, 9, and 13 through 15 are rejected under 35 U.S.C. 102(b) as being anticipated by *Parmerlee et al. (of record)*.

*Parmerlee et al.* discloses the invention essentially as claimed, including: an enclosure or housing 31; an air-to-liquid comprising side plates 13 and 14 with flow-through holes 16 through which a coolant flows and with coils 45 and 46; and air vents or slots 18.

The reference thus reads on the claims.

6. Alternately for claims 1 and 3, claims 1, 3, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by *Cowans (of record)*.

*Cowans* discloses cooling system essentially as claimed, including an air-to-liquid heat exchanger or subcooler system 20, a fan in fan system 72, and a valve 52.

The reference thus reads on the claims.

7. Alternately for claims 1, 3, 6, 8, 9, and 13 through, claims 1, 3, 6, 8, 9, 11, 13, 14, and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by *Chu et al.*

*Chu et al.* discloses cooling system essentially as claimed, including an enclosure 30', air inlet 95, air outlet 96, an air-to-liquid heat exchanger 90, a fan 91, and a modulating valve 117. Fan motor 92 is a piece of heat-producing equipment. See Figure 3B in particular.

The reference thus reads on the claims.

### *Claim Rejections - 35 U.S.C. §103*

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 4 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Parmerlee et al. (of record)*.

As noted in greater detail above, *Parmerlee et al.* discloses the invention essentially as claimed, except for not necessarily identifying fans 41 and 42 as being of a particular type. Nevertheless, as noted by applicant in the instant disclosure [page 10, lines 3-14], various types of fans are known equivalents in the art, with each having particular art-known characteristics

which may make one particular type slightly more desirable than another in a given application. Thus, it is hereby reiterated that the choice of fan type is a matter of design choice well-known in the art, and that it would have been obvious to one skilled in the art at the time of invention to modify the electronic cooling arrangement of *Parmerlee et al.* by selecting that type of fan which is best suited to a particular set of design constraints (such as cost, efficiency, space requirements, noise, throughput, and power consumption levels) for a given application.

### *Allowable Subject Matter*

10. Claims 7, 12, and 17 through 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### *Conclusion*

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ljiljana (Lil) V. Ciric, whose telephone number is (571) 272-4909.

While she works a flexible schedule that varies from day to day and from week to week, Examiner Ciric may generally be reached at the Office during the work week between the hours of 10 a.m. and 6 p.m. ET.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene, can be reached at (571) 272-4930.

lvc

January 24, 2005

LJILJANA V. CIRIC
PRIMARY EXAMINER
ART UNIT 3753